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Gp/1647/23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re the Application of:

BRENNAN et al.

Serial No.: 09/458,579

Filed: December 9, 1999

Atty. File No.: 3718-6

For: "METHODS FOR IDENTIFYING
COMPOUNDS USEFUL FOR THE
REGULATION OF BODY WEIGHT
AND ASSOCIATED CONDITIONS"

Group Art Unit: 1647

Examiner: Seharaseyon, J.

RESPONSE TO
RESTRICTION REQUIREMENT

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
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ADDRESSED TO THE ASSISTANT COMMISSIONER FOR
PATENTS, WASHINGTON, DC 20231 ON 4/16/01
SHERIDAN ROSS PC.

BY:

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This response is filed in response to the Restriction Requirement having a mailing date of March 16, 2001. This response is believed to be timely and therefore, no fees are enclosed. In the event that fees are due in connection with this response, please debit Deposit Account No. 19-1970.

The Examiner has restricted the present application into three groups of claims, as follows: Group I (Claims 1-9 and 15-21), directed to a method for identifying compounds that regulate body weight; Group II (Claims 10, 11, 13 and 14), directed to a method for identifying compounds that regulate body weight in a test animal; and Group III (Claim 12), directed to a method of identifying compounds that regulate body weight of Claim 10, wherein the test animal is a genetically modified non-human animal comprising a genetic modification within two alleles of its *Pomc* locus. Applicants provisionally elect with traverse to prosecute Group I (Claims 1-9 and 15-21).

Applicants traverse the restriction between Groups I, II and III. The Patent Office may require restriction if two or more "independent and distinct" inventions are claimed in one application. However, "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. Section 803.

With regard to the restriction between Group I and either of Groups II or III, Applicants submit that, in the present case, the subject matter of these Groups cited by the Examiner is

sufficiently small and is so closely related as to be capable of examination together. More specifically, the methods share many of the same process steps such that examination of all groups together would not place an undue burden on the Examiner. The restriction requirements in this case only serve to increase the prosecution expense to the Applicants and to the Patent and Trademark Office.

With regard to the restriction between Groups II and III, Applicants note that Claim 12 of Group III depends from Claim 10 of Group II. Indeed, Claim 12 recites one specific embodiment of the non-human test animal of Group II, and therefore, Applicants submit that the claims of Groups II and III are merely different definitions of the disclosed subject matter, differing in breadth or scope of definition. MPEP 806.03. Moreover, the method of Claim 12 does not differ from the method of Group II by any materially different starting materials or any materially different process steps, nor has the Examiner identified how these claims differ in this regard. Clearly, a thorough search for the method of Group II will include the subject matter of Group III.

In view of the foregoing discussion, Applicants request that the Examiner withdraw the restriction of Groups I, II and III.

Respectfully submitted,

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Date: April 16, 2001